

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated June 26, 2008. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-20 are pending in the Application. By means of the present amendment, claims the claims are amended including for better conformance to U.S. practice, putting method claims in better U.S. form. By these amendments, the claims are not amended to address issues of patentability and Applicants respectfully reserve all rights under the Doctrine of Equivalents. Applicants furthermore reserve the right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or continuing applications.

In the Office Action, claims 1-10 and 12-20 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,424,606 to Okazaki ("Okazaki"). Claim 11 is rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Okazaki in view of U.S. Patent No. 7,047,386 to Ngalet ("Ngalet"). It is respectfully submitted that claims 1-20 are allowable over Okazaki alone and in view of Ngalet for at least the following reasons.

The Office Action has maintained that Okazaki's detecting vibrations of a storage device anticipates "monitor the performance of the storage device" as recited in claims 1 and 17 (see, Office Action, page 6, "Response to Arguments" section). This position is respectfully refuted.

The Applicants recognized that "[p]rior-art systems try to kill the vibrations but do it in a rigid way, even when this is not necessary. For example, when the storage device is not in use and the pick-up unit is in a safe position, vibrations cannot degrade the performance of the storage device. Therefore, the vibrations do not have to be killed. Furthermore, when only little performance is needed, say 20% of the nominal performance, and vibrations bring down performance to a level of 50% of the nominal performance, the vibrations do not have to be killed either." (See, present patent application, page 6, lines 28-33.) It is respectfully submitted that Okazaki is just such a rigid system.

Okazaki does not monitor the performance of the storage device but rather Okazaki "includes a vibration detector circuit 190 for detecting the vibration of the optical pickup assembly 130." (See, Okazaki, Col. 6, lines 16-19.) As made clear, Okazaki simply measures the (emphasis added) "degree of vibration of the optical

pickup assembly 130 to the microcontroller 150." (See, Okazaki, Col. 6, lines 22-23.) Okazaki further makes clear that "the microcontroller 150 can then determine whether the detected degree of vibration is within predefined allowable limits and take appropriate action ..." (See, Okazaki, Col. 6, lines 23-26.)

In fact, Okazaki shows taking action (e.g., reducing rotation speed of the storage device) without regard to the performance of the storage device (e.g., See, Okazaki, Col. 8, line 65 through Col. 9, line 12). However, unlike Okazaki, the Applicants recognized that (emphasis added) "it is not desirable to unnecessarily modify [system characteristics such as] the sound volume because this is annoying for a user." (See, present patent application, page 7, lines 1-3.) Importantly, (emphasis added) "[u]sing the method according to the [present] invention, action is only taken to reduce the vibrations when the vibrations cause unacceptable degradation of the performance of the storage device; when the performance drops below a pre-determined level." (See, present patent application, page 7, lines 3-5.)

The interpretation of the Office Action as reading the "vibration detection" of Okazaki as anticipating the "monitoring the performance of the storage device" recited in claims 1 and 7 is

respectfully traversed. However, in the interest of expediting consideration and allowance of the pending claims, the Applicants have elected to amend claims 1 and 17 to recite that "the performance of the storage device includes at least one of sound production, access time of the storage device, data access rate, and data storage rate".

It is respectfully submitted that the method of claim 1 is not anticipated or made obvious by the teachings of Okazaki. For example, Okazaki does not disclose or suggest, a method that amongst other patentable elements, comprises (illustrative emphasis added) "monitoring the performance of the storage device; and when the performance of the storage device decreases below a pre-determined level, taking action to reduce the influence of vibrations generated by the source of vibrations, wherein the performance of the storage device includes at least one of sound production, access time of the storage device, data access rate, and data storage rate" as recited in claim 1, and as similarly recited in claim 17. Ngalet is introduced for allegedly showing elements of a dependent claim and as such, does nothing to cure the deficiencies in Okazaki.

Based on the foregoing, the Applicants respectfully submit that independent claims 1 and 17 are patentable over Okazaki and notice to this effect is earnestly solicited. Claims 2-16 and 18-20 respectively depend from one of claims 1 and 17 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims.

For example, the Office Action in maintaining the 35 U.S.C. §102(e) rejection of dependent claims, admits that although "Okazaki fails to disclose a loudspeaker", nonetheless the Office Action concludes that (emphasis added) "it is inherent that the output of the signal can be connected to a loudspeaker." (See, Office Action, page 7, lines 1-2.) Further, again though the Office Action admits that "Okazaki fails to teach that the decrease in performance below a predetermined level, if concurrent with an environmental temperature of the storage device that is above a further pre-determined level, results in no action being taken, as long as conditions exist that are not detrimental to the system", the Office Action nonetheless concludes that (emphasis added) "[t]hese kinds of parameters are inherently part of any system design." (See, Office Action, page 7, lines 3-7.)

The Applicants respectfully notes that a missing element is

inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art. Mere possibilities or even probabilities are not enough; necessity recognized by those of skill in the art is required.¹ The M.P.E.P. echoes this case law.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

Further, the following is also emphasized:

In relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

¹ The Federal Circuit has clearly set out the standard for inherency in, *e.g.*, Continental Can Co. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)(emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting *Hansgirk v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

This citation is also set out in M.P.E.P. § 2131.01(d).

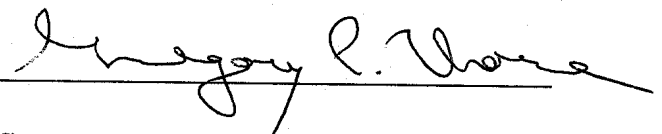
It is well established that a recited element or act is inherently present in a prior art reference only if that element is necessarily present or necessarily performed in that reference, and further that its presence or performance would be recognized by one of ordinary skill in the art from what has been expressly described. The Office Action must provide objective evidence or cogent technical reasoning to support a contention of inherency. Accordingly, without some objective evidence or cogent technical reasoning to support the contention of inherency, the rejection of the dependent claims based on the inherency allegation must be withdrawn.

Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

By 

Gregory L. Thorne, Reg. 39,398
Attorney for Applicant(s)
September 26, 2008

THORNE & HALAJIAN, LLP
Applied Technology Center
111 West Main Street
Bay Shore, NY 11706
Tel: (631) 665-5139
Fax: (631) 665-5101